

## REMARKS

This is intended as a full and complete response to the Office Action dated July 6, 2004, having a shortened statutory period for response set to expire on October 6, 2004, 2004. Please consider the claims pending in the application for reasons discussed below.

### *Specification*

The disclosure stands objected to because the parent application data should be updated. Accordingly, paragraph [0001] of the specification has been amended to insert the issued patent number.

### *Drawings*

The drawings stand objected to because the reference numbers in Figure 8 do not match the description in the disclosure, Figures 1-3 are not labeled as "Prior Art," the drawings do not include reference signs 207 and 300 mentioned in the description, and the drawings include reference signs 305, 307, and 310 that are not in the description.

Applicants revised the drawings and amended the specification to properly include all reference numbers in the drawings that are in the description, omit all reference numbers from the drawings that are not in the description, and change the reference numbers so that the same reference number is not used to designate different parts. Applicants revised the drawings to include a legend on Figures 1-3 indicating "Prior Art."

### *Claim Rejections*

Claims 15 and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Sawyer* (U.S. Patent No. 6,273,190). In response, Applicants canceled claims 15 and 19. Furthermore, Applicants respectfully submit that the new claims are patentable over *Sawyer* and *Cumming et al.* (U.S. Patent No. 6,070,671, cited in the parent application).

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Sawyer fails to teach, show or suggest expanding a tubular as claimed. *Cumming et al.* discloses expanding an expandable tubular inserted into a lateral borehole by moving an expansion mandrel having a fixed diameter conical ceramic outer surface. Thus, the expansion mandrel of *Cumming et al.* expands the expandable tubular uniformly along its length according to the fixed outer diameter of the expansion mandrel. *Cumming et al.* fails to teach, show or suggest expanding a liner extending into a lateral wellbore through a window with an expander having the claimed features. Applicants respectfully submit that a combination of *Cumming et al.* with the expander tool illustrated as prior art in Figure 1-3 of the present application would not be obvious since obviousness requires that the teaching or suggestion to make the claimed combination must be found in the prior art and not in the Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Further, *In re Mills* states that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. 916 F.2d 680 (Fed. Cir. 1990). There is no suggestion or motivation in *Cumming et al.* or in knowledge generally available to one of ordinary skill in the art to combine the expander tool in the present application with *Cumming et al.* In conclusion, the cited references, alone or in combination, fail to teach, show or suggest expanding a liner extending into a lateral wellbore through a window with an expander having features as claimed.

#### ***Allowable Subject Matter***

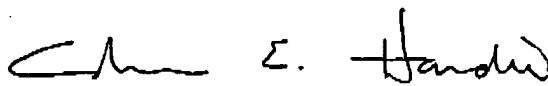
Claims 1-14, 16-18 and 20 have been cancelled without prejudice as those claims are the subject of U.S. Patent No. 6,708,769.

**Conclusion**

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the references discussed herein. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

The references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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